

**REMARKS**

The restriction requirement in the present invention is based on the Examiner's contention that the claims are directed into two purportedly separate inventions: Class I (claims 1-4) and Class II (claims 10-25).

**Provisional Election With Traverse**

Applicant provisionally elects to prosecute the Class II claims, claims 10-25, with traverse, and without prejudice to prosecuting the Class I claims, claims 1-4, in the present application or in a later application.

**The Restriction Requirement Is Improper**

Applicant respectfully submits that the stated reason for the restriction requirement, that "Claims 1-4, drawn to a library having shelf module and drive module, classified in class 369, subclass 30.38" and "Claims 10-25, to a library with shelf module, drive module, and robotic transport, classified in class 369, subclass 30.45" is incorrect and misapprehends the claimed invention.

As Examiner asserts, claims 1-4 and 10-25 are both drawn to a library having shelf module and drive module, however Examiner contends that only claims 10-25 are drawn to a robotic transport under subclass 30.45. Subclass 30.45 is drawn to a "Picker support structure (i.e., mechanism for moving picker): This subclass is indented under subclass 30.4. Subject matter including specifics of a mechanism which guides and translates a gripper assembly used to transport the disc cartridges within the storage system" (USPTO Website under Guidance, Tools, and Manuals > Classification > Class Schedule). This is incorrect, claims 1-4 are, in fact, drawn to both a cartridge transport device and a magazine

transport device as recited in claim 1, “A magazine-based data cartridge library comprising:...a cartridge transport device, operatively attached to said frame, for moving a data cartridge between a data cartridge magazine and said drive; a magazine transport device, operatively attached to said frame, for moving a data cartridge magazine...” Hence, both purported Class I and Class II are drawn to class 369, subclass 30.45.

Examiner further asserts that purported Class II and Class I, which are related as combination and subcombination, are distinct because “In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require some particular feature cited in the subcombination, such as “a first side that is exposed to said cartridge transport device,” and “said first side that is exposed to said cartridge transport device and magazine transport device.”” This is incorrect because the purported combination as claimed recites, “said shelf module is adapted to receive said third data cartridge magazine through a magazine opening facing said transport space” which can be a first side of the purported subcombination. Hence, both the purported combination and subcombination as claimed do recite the same specific characteristic.

Examiner also asserts that the “subcombination has separate utility such as used in a library without the robotic magazine transport recited in the combination.” This is incorrect, the purported subcombination recites “a magazine transport device, operatively attached to said frame, for moving a data cartridge magazine.” The robotic magazine transport of the purported combination is merely a narrower embodiment of a magazine transport device of the purported subcombination serving the same function as the broader magazine transport device. Both the purported subcombination and combination require a magazine transport device and hence do not have separate utility. MPEP § 806.05(c).

Thus, Applicant respectfully submits that the basis for the restriction requirement is erroneous, and that no showing has been made that the combination and subcombination are separately useable and therefore distinct from each other. MPEP § 806.05(d).

\* \* \*

Authorization To Charge Necessary Fees

While no fee is believed due with this submission, the Commissioner is hereby authorized to charge any necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-0289.

Respectfully submitted,

Dated: 3/30/06



Kenneth Altshuler  
Reg. No. 50,551

Correspondence Address  
WALL MARJAMA & BILINSKI LLP  
101 South Salina Street, Suite 400  
Syracuse, New York 13202  
Telephone: (315) 425-9000  
Facsimile: (315) 425-9114

Customer No.: 20874  
PATENT TRADEMARK OFFICE